

REMARKS

In the Final Office Action, the Examiner rejected claims 1-7, 9-26, and 46-53, and the Examiner withdrew claims 27-45 from consideration. Reconsideration of the application in view of the remarks set forth below is respectfully requested.

Election/Restrictions

In the Final Office Action, the Examiner withdrew claims 27-45 from consideration as being directed to a non-elected invention. Specifically, the Examiner stated:

Newly submitted claims 27 – 45 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The previously presented claims were drawn to an embodiment where the sensor memory stores formulas and functions, wherein the embodiments presented in the newly submitted claims are drawn to an invention that includes a sensor that stores *only* coefficients and has an oximeter that stores the formulas.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27 – 45 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Final Office Action, page 2 (emphasis added).

In accordance with 37 C.F.R. § 1.143, the Applicants elect to prosecute claims 1-7, 9-26, and 46-53 *with traverse*. After careful review of the Examiner's restriction requirement, the claims, the specification, and the Manual of Patent Examining Procedure, the Applicants believe that the Examiner's restriction requirement is improper and must be withdrawn. As discussed below, the potential for interpreting the claims to include a single embodiment, the lack of

serious burden to examine all claims, and the policy against *piecemeal* examination require that the Examiner withdraw the restriction requirement and examine all pending claims.

First, Applicants respectfully remind the Examiner that where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction there between should never be required. *See* M.P.E.P. § 806.03. Further, Applicants assert that all of the pending claims, including withdrawn claims 27-45, may be interpreted to include the same essential characteristics of a single disclosed embodiment of the invention. For example, all of the pending claims may include a sensor that stores formulas and coefficients, as described in the specification. The Examiner's assertion that claims 27-45 are limited to "a sensor that stores *only* coefficients" is improper. Final Office Action, page 2 (emphasis added). Indeed, none of the withdrawn claims requires that the sensor store "only" coefficients. Accordingly, Applicants assert that the Examiner's restriction is improperly based on a non-existent limitation inserted by the Examiner.

Second, the Applicants object to the Examiner's restriction requirement on the ground of a lack of "serious burden" on the Examiner. As set forth in the Manual of Patent Examining Procedure, the criteria for a restriction requirement includes: (1) the inventions must be independent or distinct, AND (2) there would be a serious burden on the Examiner if restriction is not required. *See* M.P.E.P. §§ 802.02 and 803. In this case, the Applicants stress that the prosecution history evidences no burden, much less a "serious burden," on the Examiner. For example, during the course of prosecution of the present application, the Examiner evaluated

original claims that were broad enough to be generic to all of the present claims. Indeed, original claim 1 did not include a recitation as to where the first and second different formulas could be stored. Thus, the newly added claims are not directed to “an invention other than previously claimed,” as set forth in M.P.E.P. § 821.03. Accordingly, the continued examination of the original and amended claims will not be any additional burden, much less a “serious burden,” because all of the present claim features are generally within the scope of the originally filed claims. Again, the Applicants stress that:

If the search and examination of all the claims in an application can be made *without serious burden*, the examiner *must* examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. § 803.

Third, with reference to the Manual of Patent Examining Procedure, the Applicants also emphasize that “[p]iecemeal examination should be avoided as much as possible.”

M.P.E.P. § 707.07(g). Moreover, “the examiner should never overlook the importance of his or her role in allowing claims which properly define the invention.” *Id.* at § 706. For these reasons among others, the Applicants respectfully request that the Examiner withdraw the restriction requirement and allow the pending claims.

Claim Rejections under 35 U.S.C. § 112

In the Final Office Action, the Examiner rejected claims 1-7, 9-26 and 46-53 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner maintained a previous rejection of claims 1-7 and 9-17 under 35

U.S.C. § 112. Additionally, it appears that the Examiner applied the previous rejection of claims 1-7 and 9-17 under 35 U.S.C. § 112 to newly added claims 18-26 and 46-54 without specifically addressing the newly added claims. In the previous rejection, the Examiner stated the following:

Claims 1 - 7 and 9 - 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed discloses that the memory stores coefficients (used in formulas) and breakpoints (used to indicate when to use a particular formula) [see originally filed Figures 2 and 3 and the descriptions thereof]. Further, the originally filed specification teaches that different formulas may be used for different sections of the saturation curve. However, these formulas are resident in the sensor reader/monitor. There is no teaching or suggestion that the sensor memory include the formulas or algorithms, only that the coefficients and breakpoints are stored therein. As such, the claims contain subject matter that was not adequately described by the specification as originally filed, and therefore Applicant did not have possession of the claimed invention at the time the application was filed.

Office Action Mailed June 26, 2006, page 2.

The Applicants respectfully traverse this rejection. Regarding the written description requirement, the initial burden of proof regarding the sufficiency of the written description falls on the Examiner. Accordingly, the Examiner must present evidence or reasons why persons skilled in the art would not recognize a description of the claimed subject matter in the applicant's disclosure. *In re Wertheim*, 541 F.2d 257, 262, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976). The Examiner is also reminded that the written description requirement does not require the claims to recite the same terminology used in the disclosure. *Ellipse Corp. v. Ford Motor Co.*,

171 U.S.P.Q. 513, 517 (7th Cir. 1971), *aff'd*, 613 F.2d 775 (7th Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). Moreover, any information contained in any part of the application as filed, including the specification, claims, and drawings, may be added to other portions of the application without introducing new matter. M.P.E.P. § 2163.06.

The Applicants respectfully submit that one of ordinary skill in the art with the benefit of the present disclosure would recognize the invention set forth in the claims. Specifically, one of ordinary skill in the art would recognize that the specification clearly teaches that the formulas may be stored in the sensor memory. In fact, the specification need not specifically state that “formulas” may be stored on the sensor memory, since the claims are not required to recite the same terminology used in the disclosure. *See Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513, 517 (7th Cir. 1971), *aff'd*, 613 F.2d 775 (7th Cir. 1979), *cert. denied*, 446 U.S. 939 (1980).

As the Examiner has recognized, the formulas may be stored on the monitor. Office Action Mailed June 26, 2006, page 2. However, the formulas also may be stored on the sensor memory, as recited by independent claims 1, 6, 11, 13, and 46. For example, the specification discloses compressing “functions” to allow storage of those functions on a limited sensor memory. *See Application*, page 9, lines 15-17. The specification states that “any function can be used for the formulas for determining oxygen saturation For a limited *sensor memory*, the *function* representation may be compressed.” *Application*, page 9, lines 15-17 (emphasis added). One skilled in the art would recognize that the reason for compressing the functions (i.e., formulas) is to allow the formulas to be stored on a memory with limited capacity. If the

formulas were only stored on the monitor memory, there would be no need to compress them for a limited *sensor* memory.

In the Response to Arguments section of the Final Office Action, the Examiner stated that the Applicants' arguments set forth above are unpersuasive because the portion of the specification quoted by the Applicants does not explicitly or inherently teach storing the functions on the sensor memory. To support this argument, the Examiner stated the following:

As the quoted passage indicates that "any function can be used" and "[a]ny representation of a function could be used," the chosen function could be quite complex, involving multiple variables and constants, thereby requiring multiple coefficients to be stored on the memory. Such a situation would overwhelm the capacity of the limited sensor memory. However, mathematical assumptions and approximations may be employed to "compress" the function to remove the need to store some of the coefficients and allow the limited memory to store the needed data.

Final Office Action, page 3.

Applicants stress that, in the portion of the specification quoted above, a direct correlation is made between the compression of the *function* and limited sensor memory. Again, the specification states, "For a limited *sensor memory*, the *function* representation may be compressed." Application, page 9, lines 15-17 (emphasis added). There is no mention of how compressing the *function* may reduce the number of coefficients that are stored. Accordingly, Applicants assert that, in context, a reasonable interpretation of the text quoted from the specification above would suggest that the *functions* are stored on the limited sensor memory and may be compressed to facilitate their storage. Further, Applicants assert that this interpretation is not contrary to the teachings of the specification. While the Examiner's arguments on pages 3

and 4 of the Final Office Action suggest that the rest of the specification is directed to storing formulas/functions on a monitor, Applicants do not find any support for limiting the scope of the present application to storing formulas/functions *only* on a monitor.

The Examiner made an additional argument in the Response to Arguments section of the Final Office Action that the Applicants would like to address. Specifically, the Examiner stated the following:

[T]he specification still does not teach or suggest storing two sets of coefficients and two functions, as set forth in the claims. In fact, if the formulas were stored on the memory this would eliminate the need to store coefficients on the memory, as this would merely duplicate information contained in the formula without enhancing the usefulness of the device.

Final Office Action, page 4.

Applicants assert that the present application clearly discloses the use of two functions or formulas for determining oxygen saturation. *See e.g.*, Application, page 3, lines 30-33. Indeed, many of the originally filed claims recite that a memory storing first and second different formulas for determining oxygen saturation. Further, in view of the disclosure relating to storage of functions on a limited sensor memory, one of ordinary skill in the art would recognize that two functions would be stored on a sensor memory in certain embodiments. Additionally, as set forth throughout the specification, multiple different coefficients may be utilized with a single formula depending on the application. *See, e.g.*, Application, page 6, lines 3-25. For example, a single formula may have one set of coefficients for a first saturation range and a second set of coefficients for a second saturation range. Accordingly, storing coefficients in addition to

formulas on a single memory would not be a mere duplication of stored information, as suggested by the Examiner.

In view of the teaching of the present application, the Applicants respectfully assert that the specification clearly teaches storing formulas in the sensor memory. Furthermore, if the Examiner disagrees with this assertion, the Applicants respectfully remind the Examiner of his burden to set forth evidence or reasoning why one of ordinary skill in the art would *not* recognize the claimed invention in the disclosure *despite the teaching in the application noted above*. See *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90, 97 (C.C.P.A. 1976).

In view of the remarks set forth above, the Applicants respectfully submit that a person of ordinary skill in the art would recognize a description of the subject matter of claims 1, 6, 11, 13, and 46 in the disclosure. For at least these reasons among others, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, first paragraph and allowance of claims 1, 6, 11, 13, and 46. Further, Applicants request an indication of allowance for the claims depending from claims 1, 6, 11, 13, and 46 based on their dependency from these independent claims, and for the unique matter recited in each dependent claim.

Request for Interview

Applicants respectfully request an interview with the Examiner before the Examiner provides an Advisory Action. Accordingly, Applicants presently submit the attached Applicant Initiated Interview Request Form.

Conclusion

In view of the remarks set forth above, the Applicants respectfully request reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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